

### **REMARKS/ARGUMENTS**

This Amendment and the following remarks are intended to fully respond to the Office Action dated February 9, 2005. In that Office Action, claims 1-26 were examined, and all claims were rejected. More specifically, claims 8, 9 and 18 were objected to because their formats are improper; claims 1-7, 10-13, 14-17 and 19-26 stand rejected under 35 U.S.C. § 101 because they are directed to non-statutory subject matter; claims 1-7, 11-13 and 20-21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; claim 10 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Vahalia et al. (USPN 6,389,420); and claims 1, 6-8, 11, 12, 14-20 and 22-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vahalia et al.

#### **Claim Objections**

Claims 8, 9 and 18 were objected to due to arguably improper format. Claims 8, 9 and 18 claim computer readable mediums and other computer products with instructions to perform certain steps as approved in In re Beauregard, 35 USPQ2d 1383 (Fed. Cir. 1995). Although these claims are written in a format that defines, in dependent form, a computer or memory that enables performance of the steps in the base claims, Applicant submits that this form is proper. The claims clearly define the subject matter of the claims as required by 35 U.S.C. § 112.

In fact, the primary difference between the claims in Beauregard and the instant claims is that the instant claims are crafted in a dependent format. Often this format raises an initial concern because the preambles differ from the base claims to the dependent claims. However, the present dependent claims also comply with a format generally approved by the Board of Patent Appeals and Interferences in Ex parte Adrianus P.M.M. Moelands, 3 USPQ2d 1474 (PTO Board of Pat App and Int 1987). In Moelands, the Board upheld as appropriate the following dependent claim to a data transmission system:

11. A data transmission system comprising:

at least two of the data transmission stations of claim 10;

a clock bus interconnecting the clock terminals of the stations; and

means which maintain the clock bus at the second voltage level in the absence of forcing by the stations.

The preamble in claim 11 to a "data transmission system" was different than the preamble in claim 10 to a "data transmission station". Yet, the Board held that this dependent claim format satisfies the statutory requirements of both the second and fourth paragraphs of 35 U.S.C. §112. Therefore, Applicant respectfully submits that claims 8, 9 and 18 are not improper because of format issues and respectfully requests that the objection to claims 8, 9, and 18 be withdrawn.

#### **Claim Rejections – 35 U.S.C. § 101**

Claims 1-7, 10-13, 14-17 and 19-26 stand rejected under 35 U.S.C. § 101. The Examiner asserts that these claims are directed to non-statutory subject matter because these are method claims. Applicant traverses this rejection as 35 U.S.C. § 101 clearly states "Whoever invents or discovers any new and useful *process*... may obtain a patent therefore..." (emphasis added). Indeed method claims have been statutory for a very long time. However, Applicant has amended the preamble of these claims to speed up prosecution.

Regarding claim 10, computer readable medium claims and, in particular, data structure claims have been held to be proper in In re Beauregard, 35 USPQ2d 1383 (Fed. Cir. 1995) and In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Applicant also directs the examiners attention to MPEP § 2106, which explains these type of claims. Applicant submits this type of claim has been allowable for many years. In view of the above reasons, Applicant respectfully requests that the rejection to claim 10 be withdrawn.

Regarding claims 19-26, these claims are directed to one or more systems with modules to perform certain tasks, which is an apparatus claim. Again Applicant submits this type of claim is statutory under 35 U.S.C. § 101 as an apparatus. However, the Applicant has amended claim 19 to include a computer system to alleviate this rejection. In light of this amendment Applicant respectfully requests claims 19-26 be allowed.

**Claim Rejections – 35 U.S.C. § 112**

Claims 1-7, 11-13 and 20-21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A.
- a. The examiner objected to the term “the retry” in claim 1 as lacking antecedent basis. The Applicant has corrected this informality and thanks the examiner for pointing this out.
  - b. The examiner objected to the term “the lock information” in claim 2 as lacking antecedent basis. Applicant directs the examiner’s attention to line 6 of claim 1 which includes the antecedent basis for this term.
  - c. The examiner objected to the term “the lock owner” in claim 3 as lacking antecedent basis. The Applicant has corrected this informality and thanks the examiner for pointing this out.
  - d. The examiner objected to the term “the search strategy” in claims 5 and 7 as lacking antecedent basis. The Applicant has corrected these informalities and thanks the examiner for pointing this out.
  - e. The examiner objected to the term “the time period” in claim 5 as lacking antecedent basis. The Applicant has corrected this informality and thanks the examiner for pointing this out.
  - f. The examiner objected to the terms “the lock property” and “the sharing property” in claim 6 as lacking antecedent basis. The Applicant has corrected these informalities and thanks the examiner for pointing this out.
  - g. The examiner objected to the term “the type of request” in claim 7 as lacking antecedent basis. The Applicant has corrected this informality and thanks the examiner for pointing this out.

h. The examiner objected to the term “the requested” in claim 11 as lacking antecedent basis. Applicant directs the examiner’s attention to line 3 of claim 11, which includes the antecedent basis for this term.

i. The examiner objected to the term “an owning client application program” in claim 20 as lacking antecedent basis. Applicant submits this is in proper form and requires no antecedent basis.

B. The examiner objected to the claim language in claim 4. The Applicant submits that the modification of a request *strategy* in claim 4 is different than the request *to access* the resource in claim 1. Applicant submits this adds a limitation and is proper form.

#### **Claim Rejections – 35 U.S.C. § 102**

Claim 10 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Vahalia et al. (USPN 6,389,420). In order for a reference to anticipate a claim under any sub-section of 35 U.S.C. § 102, the reference must disclose each and every element as set forth in the claim.

Verdegaal Bros. v. Union Oil Col. of California, 814 F.2d 628, 631 (Fed. Cir. 1987)). As argued in the following remarks, Vahalia et al. does not disclose each and every element of any claim pending in the present application, and as such, Applicant respectfully contends that the instant rejections based thereon are improper and should be withdrawn. Regarding claim 10, Vahalia et al. does not show the limitation of a lock object including an expected lifetime property as required by claim 10 of the present disclosure. As stated in the specification at page 5, line 1-3 the expected lifetime property is used so that the server may notify requesting clients as to the expected lifetime of a lock to improve client-side polling methods. Vahalia et al. discloses a lock expiration timer, however Vahalia et al. does not show an expectancy lifetime property as described and used in claim 10. Furthermore, the expiration timer of Vahalia et al. could not be utilized in a manner described in the present disclosure. For these reasons, Applicant submits claim 10 of the present disclosure is allowable over the reference cites, and respectfully requests it be allowed.

**Claim Rejections – 35 U.S.C. § 103**

Claims 1, 6-8, 11, 12, 14-20 and 22-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vahalia et al. In order to establish *prima facie* obviousness under 35 U.S.C. 103(a), three basic criteria must be met, namely: (1) there must be some suggestion or motivation to combine the references or modify the reference teaching; (2) there must be a reasonable expectation of success; and (3) the reference or references when combined must teach or suggest each claim limitation (Manual of Patent Examining Procedure §2142 et. seq.) Applicant submits that the Office Action failed to state a *prima facie* case of obviousness, and therefore the burden has not properly shifted to Applicants to present evidence of nonobviousness.

Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness because the reference fails to disclose or suggest all of the limitations of the pending claims, specifically as to claim 1, no reference has shown or disclosed the returning of lock information to the requesting client computer system upon determining the existence of a conflicting lock, so that the retry strategy of the requesting client computer system may be modified. The Examiner argues that one skilled in the art would modify the retry strategy, but provides no support of such a statement. Not only does the Examiner ignore the fact that no reference provides such information to the requesting client system, but such statement about what those skilled in the art might do without support does not satisfy the burden. Because the examiner has failed to establish a *prima facie* obviousness under 35 U.S.C. 103(a), Applicant submits that independent claim 1 is allowable over the cited references, and respectfully request it be allowed. Since claims 6-8 depend from allowable claim 1, Applicant submits they are also allowable, and respectfully requests they be allowed.

Futhermore, the Examiner is picking and choosing elements with no connection, which is impermissible hindsight. In In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992), the Federal Circuit stated:

It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of prior art so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that “[O]ne cannot use hindsight reconstruction to pick and choose

among isolated disclosures in the prior art to deprecate the claimed invention.” (quoting *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600).

Here the examiner is stating that certain elements would have been known by one skilled in the art, with no supporting reference or motivation. Applicant submits this is impermissible. For these additional reasons, the examiner has failed to establish a *prima facie* obviousness under 35 U.S.C. 103(a). Applicant submits that independent claim 1 is allowable over the cited references, and respectfully requests it be allowed. Since claims 6-8 depend from allowable claim 1, Applicant submits they are also allowable, and respectfully requests they be allowed.

Regarding claim 11, again Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness because the reference fails to disclose or suggest all of the limitations of the pending claims, specifically as to claim 11, the Examiner has failed to provide a citation to a reference for this limitation. Furthermore, no reference has shown or disclosed blocking the resource for the requesting client computer system until the resource is free, if the resource has a conflicting lock. Vahalia et al. may show locking a resource with a lock on the resource, but does not teach or suggest blocking the resource for the requesting client computer system. The present disclosure provides for a block to be put on a resource, by the requesting client, if the resource is locked. This effectively preserves a “place in line” for the requesting client, such that the requesting client is next to utilize the resource. Nowhere does the cited reference suggest or disclose this limitation. As such, the Applicant submits claim 11 is now allowable over the cited reference and respectfully requests it be allowed. Since claims 12-13 depend from allowable claim 11, Applicant submits they are also allowable, and respectfully requests they be allowed.

Regarding claim 14, again the examiner has not provided a reference, or a motivation showing the limitation of a request to break a lock object or under what circumstances a lock object could be broken, as required by claim 14 of the present disclosure. Again the Applicant submits the examiner is using improper hind sight and has failed to establish a *prima facie* obviousness. For these additional reasons, the examiner has failed to establish a *prima facie* obviousness under 35 U.S.C. 103(a). Applicant submits that independent claim 14 is allowable over the cited references, and respectfully requests it be allowed. Since claims 15-18 depend from allowable claim 14, Applicant submits they are also allowable, and respectfully requests they be allowed.

Regarding claim 19, the Applicant has amended claim 19 to include the limitation of the lock information returned to the requesting client application program relates to the expected lifetime of the lock. Nowhere in Vahalia et al. is disclosed or suggested the lock information returned to the requesting client include the expected lifetime of the lock. The Applicant submits claim 19 is now allowable over the cited reference and respectfully requests it be allowed. Since claims 20-26 depend from allowable claim 19, Applicant submits it is also allowable, and respectfully requests it be allowed.

**Claims 2-5**

As the Examiner has provided no rejections for claims 2-5, Applicant submits they are now allowable with the minor corrections suggested by the Examiner. The Applicant respectfully requests these claims be allowed.

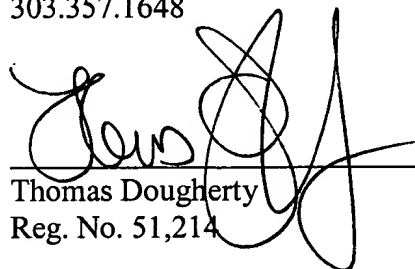
**Conclusion**

A Petition for a one-month extension of time is enclosed with this Response, along with our check in the amount of \$120. It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

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